



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

RECEIVED
#101700
APR 3 2003
TC 51700
[Signature]

In re Patent Application of

MANZ et al

Serial No. 10/046,564

Filed: January 16, 2002

For: FLUID TRANSPORT APPARATUS AND METHOD

Atty. Ref.: 550-308

Group: 1723

Examiner: E. Therkorn

* * * * *

April 3, 2003

Assistant Commissioner for Patents
Washington, DC 20231

Sir:

RESPONSE TO RESTRICTION REQUIREMENT

This is responsive to the Restriction Requirement mailed February 3, 2003 (Paper No. 7), the date of response to which has been extended one month up to and including April 3, 2003, in view of the attached one-month extension of time petition and petition fee.

Remarks

Applicants elect with vigorous traverse the invention of Group I including claims 1, 3-13, 15 and 16. Even though claims 2, 14 and 17-20 all ultimately depend from claim 1 and thus serve to further limit and define the invention of claim 1 (35 USC §112 (4th paragraph)), the Examiner does not identify claim 1 as a generic claim. The Examiner instead suggests that claims 2, 14 and 17-20 are a different invention from that of claim 1. Pursuant to the dictates of the 4th paragraph of section 112, claim 2 further limits the invention of Claim 1. Applicants claim 2 limits the "fluid transport apparatus"

of claim 1, by specifying that it is a "chromatographic system" and that the "transport channel includes a separation channel." Thus, claim 2 clearly limits the invention of claim 1 in accordance with the statute and, by definition, cannot be a different invention.

The Examiner's attention is additionally directed to the definition of "independent" and "distinct" as set out in Section 802.01 of the Manual of Patent Examining Procedure. The term "independent" means that there is no disclosed relationship between the two or more subjects disclosed, i.e. they are unconnected in design, operation, or effect. Claim 2, dependent upon claim 1 is clearly not "independent" thereof.

Moreover, the Examiner has utilized PTO form paragraph 8.14 of the Manual of Patent Examining Procedure improperly, and the Examiner's attention is directed to the examiner's note in the MPEP. It indicates that "the intermediate and final product must have a **mutually exclusive species relationship** and as with all species restrictions, must be patentably distinct." (emphasis added).

The Examiner has not indicated how or in what manner he believes independent claim 1 provides a "mutually exclusive species relationship" with respect to dependent claim 2. Because these claims are the broadest claims in the two allegedly separate inventions set out by the Examiner in the Official Action (inventions of Groups I and II), they must have a mutually exclusive species relationship in order for form paragraph 8.14 to apply. They simply do not and the Examiner's blunt force attempts to fit a square peg into a round hole clearly fail.

The Examiner's contention is without any legal support and is contra to the indications of the Manual of Patent Examining Procedure (MPEP). It is submitted that

the Examiner should have concluded that claim 1 was generic as it is a combination of elements forming a fluid transport apparatus, and claims 2, 14 and 17-20, all of which ultimately limit claim 1, are directed towards a particular species of the fluid transport apparatus, i.e. a chromatographic system.

In fact, the Examiner has pointed to no other species of the invention set out in generic claim 1, and therefore a restriction requiring an election of one of a plurality of species would be inappropriate.

MPEP Section 806.04 provides for three separate bases for a conclusion that two or more inventions are in fact independent, i.e. two different combinations (A) are not disclosed as capable of use together, (B) where the two inventions are process and apparatus and the apparatus cannot be used to practice the process, and (C) where species under a genus claim are independent.

Regarding basis (A), the present claims do not disclose two different combinations having different modes of operations, different functions or different effects. Clearly the inventions of claims 1 & 2 can be used together because the invention of claim 2 is a subset of the invention of claim 1. Claim 1 is an apparatus for fluid transport and claim 2 limits claim 1 to a fluid transport apparatus in a chromatographic system and specifies the details of the transport channel. Therefore basis (A) is not present in the pending claims.

With respect to basis (B), while process and apparatus claims are disclosed (claim 21 comprising a fluid transport method as opposed to claim 1 being a fluid transport apparatus), it is clear that the fluid transport apparatus implements the fluid transport method and vice versa. Because these are so interrelated, the apparatus cannot

be used to practice any other process, and the process cannot be used with any other apparatus. Thus basis (B) does not exist.

Finally, with respect to basis (C), as noted above, there is only a single species disclosed. Thus, where only a single species is claimed, the species cannot be independent. As a result there is no basis under (C) and therefore the species under a genus is inappropriate.

Accordingly, pursuant to MPEP Section 806.04(A)-(C), there is no basis for the Examiner's conclusion that dependent claims 2, 14 and 17-20 are directed to an invention different from the invention set out in independent and generic claim 1 and the remaining claims dependent thereon.

Additionally, the invention of Group III is not independent of the invention of Group I, because claim 21 is directed towards a transport method, which cannot be practiced without the structure of claim 1. Therefore, applicants respectfully traverse the Examiner's conclusion that restriction among three allegedly separately inventions is respectfully traversed.

Notwithstanding applicants' vigorous traversal, applicants elect claims 1, 3-13, 15 and 16 directed to invention I with traverse and any further objection thereto is respectfully traversed.

Applicants will attempt to obtain copies of the references cited in the Bibliography listed on pages 11 and 12 of the application to the extent that such documents are believed pertinent to the presently claimed invention. Applicants also include the results

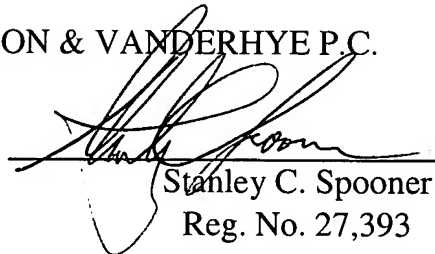
of a European Search Report and includes the appropriate PTO Form 1449 and patent copies as attached the Information Disclosure Statement submitted concurrently herewith.

Having responded to all objections and rejections set forth in the outstanding Official Action, it is submitted that claims 1-21 are directed to the same invention and reconsideration of the restriction requirement is respectfully requested. In any event, claims 1-21 are believed patentable over the prior art and notice to that effect is respectfully solicited. In the event the Examiner is of the opinion that a brief telephone or personal interview will facilitate allowance of one or more of the above claims, he is respectfully requested to contact applicants' undersigned representative.

Respectfully submitted,

NIXON & VANDERHYE P.C.

By:



Stanley C. Spooner
Reg. No. 27,393

SCS:kmm
1100 North Glebe Road, 8th Floor
Arlington, VA 22201-4714
Telephone: (703) 816-4000
Facsimile: (703) 816-4100